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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/637,623 | 08/11/2003 | Chia-Chin Wang | MR2049-349 | 2095 |
| 4586 | 7590 | 03/16/2005 | EXAMINER | |
| ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043 | | | STASHICK, ANTHONY D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

57

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|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 10/637,623 | | WANG, CHIA-CHIN | |
| | Examiner | | Art Unit | |
| | Anthony Stashick | | 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 1, line 8, “13” was used to designate both midsole and insole. Also, “insole” is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldstone 1,277,713. Goldstone ‘713 discloses all the limitations of the claims including the following: an outsole 6 having an end connected to a heel portion (see Figure 2); a midsole 4 having a support member 1 supported to an underside of the midsole (see Figure 1); the support member 1 having a side wall 2 extending perpendicularly from a periphery thereof and located at a rear end of the midsole (see Figures 1 and 3); a connection piece 13 having spikes which penetrate through the midsole and the support member and being connected to a top of the heel portion (see Figures 1-2); an insole 15 laminated on the midsole; a vamp 10 securely connected to a periphery of the outsole (see Figures 1 and 2); the support member is made of composite fibers (see col. 1, lines 52-col. 2, lines 2); the side wall 2 of the support member is adapted to extend to a plantar arch of the wear’s foot (see Figure 1, extends to the plantar arch).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstone 1,277,713 as applied to claim 1 above in view of Everston 2,383,052. Goldstone '713 as applied to claim 1 above discloses all the limitations of the claim except for the midsole and the support member being a one-piece member. Everston '052 teaches that a support member and a midsole for a shoe can be provided as a single one-piece member (portion 21) to support the user's heel as well as cushion the rest of the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the support an the midsole of Goldstone '713 a single one-piece member to prevent any slipping between the heel support and the midsole and allow for cushioning of the user's foot while supporting the heel.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstone 1,277,713 as applied to claim 1 above in view of Brown 5,772,186. Goldstone '713 as applied to claim 1 above discloses all the limitations of the claims except for the support member being made of thermosetting plastic or thermo-plastic. Brown '186 teaches that a support member (100 and 104) for supporting the heel of a user's foot can be made of thermoplastic material (see col. 7, lines 4-13) to allow for the support member to be molded to the user's foot and still be lightweight. Therefore, it would have been obvious to make the support member of Goldstone '713 as applied to claim 1 above, out of thermal plastic material, as taught by Brown '186, to

Art Unit: 3728

allow it to be molded closely to the shape of the user's foot and still provide the proper support while also being light so as to not add weight to the user's shoe.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstone 1,277,713 as applied to claim 2 above in view of Braun 6,493,966 and Maciel et al. 4,766,680. Goldstone '713 as applied to claim 2 above discloses all the limitations of the claim except for the midsole fibers being woven and the outsole being made of transparent material. Braun '966 teaches that it is well known in the art to make a midsole out of fiber that are woven together to give better strength to the sole while still allowing for absorbency. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the midsole of Goldstone '713 out of woven fibers to give the midsole better strength to resist separation. Maciel et al. '680 teaches that the outsole of a shoe can be made of transparent material to allow for sole to appear clear suggesting newness and cleanliness of the shoe to further appeal to the consumer. Therefore, it would have been obvious to make the sole of Goldstone '713 out of transparent material, as taught by Maciel et al. '680, to make the shoe look new and clean to better attract consumers.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstone 1,277,713 as applied to claim 1 above in view of Official Notice. Goldstone '713 as applied to claim 1 above discloses all the limitations of the claim except for the midsole being flush with the top edge of the sidewall of the support member. Official Notice is taken that it is well known, within the art of shoemaking, to make a sole flush with the top edge of the sidewall of a support member to prevent feeling the edge of the support member against the user's foot during use. Therefore, it would have been obvious to make the midsole of Goldstone '713 as applied to

Art Unit: 3728

claim 1 above flush with the side wall of the support member to prevent the user from feeling the edge of the support member during use and to prevent the edge of the support member from cutting into the user's foot.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstone 1,277,713 as applied above in view of Rawson 4,229,888. If it is believed that Goldstone '713 as applied in the 102 rejection above does not meet all the limitations of the claim, Rawson '888 teaches the use of a connection piece for fastening the heel and soles of a shoe together. Therefore, it would have been obvious to use the connection piece taught by Rawson '888 in place of the connectors 13 of Goldstone '713 to connect the heelpiece to the soles to have a more stable connection between the soles and the heel.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

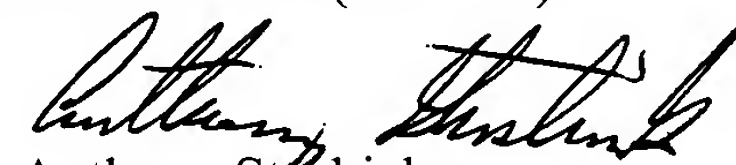
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS